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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael A. Muller

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12/11/2006

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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/810,395	MULLER, MICHAEL A.	
Examiner	Art Unit	
Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 55-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 55-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to amendment filed September 14, 2006. Applicant amended claim 65. Claims 1-22 and 55-103 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 83-92, 102 and 103 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claimed invention must fall into one of the four recognized statutory classes of invention, a process (or method), a machine (or system); an article of manufacture; or a composite of matter. However claim 83 does not seem to fall within one of these recognized categories. The invention seems to be directed toward an article of manufacture, however, computer programs claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. Such claimed computer codes do not define any structural and functional interrelationships between the computer code and other claimed elements of a computer, which permit the computer's program to be realized (see MPEP section 2106). Simply stated invention not claimed, as computer program that when executed by the computer causes the computer to perform the claimed limitation is not statutory. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting.

Dependent claims 84-92, 102 and 103 inherit the deficiency through dependence and are therefore, rejected as well.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 95-97 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are dependent to cancelled claims 23 and 33. Applicant is required to amend, for proper dependency, or cancel the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 8, 14, 15, 21, 22, 55, 56, 58, 63-65, 67, 69, 71, 75, 81-84, 86, 88, 91 and 92 are rejected under 35 U.S.C. 102(e) as being anticipated by Bahar (US 6,694,355).

Regarding claims 1, 2, 8, 55, 56, 65, 71 and 83, 88, Bahar teaches a server operable to receive formulation of a problem (product design) to be solved (see col. 3 line 35 to col. 4 line 43); receiving suggested solutions to the problem (design) (see col. 5 line 35 to col. 6 line 51); distribute portions of an award to those who contributed the suggested solutions, wherein the server is configured to distribute a portion of the award, before it is determined that the problem has been solved, to at least one participant who contributed a suggestion solution to the problem

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(selecting at least one winner to receive corresponding award) which indicates that more than one winner could be selected and the award would go to one or more participants (see col. 6 lines 31-52).

Regarding claims 4, 6, 58, 67, 69, 84, 86, 92, Bahar teaches the system adapted to manage a discussion of the problem and the suggested solutions; and to receive and display the discussion in real time; communicatively couple to a database adapted to store the formulation of the problem and suggested solutions (see col. 4 line 19 and col. 6 line 52).

Regarding claims 14, 75 Bahar teaches the tools further adapted to allow the first participant to select one of the suggested solutions and control the discussion and distribution of the portions of the award in the context of the selected suggested solution (see col. 6 lines 25-51).

Regarding claim 15, Bahar teaches wherein the formulation of the problem is related to the improvement of company processes (see col. 3 line 18 to col. 4 line 44).

Regarding claim 21 and 22, 63, 64, 81, 82, 91, the system operable to thread the discussions (see col. 3 line 52 to col. 4 line 18); wherein the first participant authorizes the level of the amount of each portion of the award before the other participants send the suggested solutions, thereby finalizing the distribution of the portions of the award (see col. 6 lines 34-41).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 7, 9-11, 16-20, 59-62, 66, 70-73, 76-80, 87, 89 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar as (US 6,694,355) applied to claim 1 above, and further in view of the article "Defense Taps 2 Finalists for Jet Contract; Military: Boeing and Lockheed Martin will build prototype of fighter. McDonnell Douglas loses out but Southland will bet a piece of the project; Robert A Rosenblatt, et al. Los Angeles Times, Nov. 17 1996 (herein after Rosenblatt).

Regarding claims 3, 7, 9, 59, 60, 66, 70, 72 and 87, Bahar does not explicitly teach wherein the distributions of the portions of the award are varied over the course of a development of the suggested solutions for the purpose of guiding the development of a final solution to the problem. Bahar also teaches operable to store tools for use by a presenter for controlling the award to the other participants (see col. 6 lines 42-51). Rosenblatt teaches the participants receiving payment during the process of the development of the project; i.e., the participants each receiving 1.1 billion to develop the demonstrator aircraft and the winner to receive more than 200 billion dollars. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to pay the participants of Bahar over the course of the development as in Rosenblatt, if the project's cost is high, so that the participant could use the money for the expense needed to develop or design the project.

Regarding claim 10, Bahar teaches wherein the other participants are viewers of a television broadcast relating to the formulation of the problem and the suggested solutions and the presenter is a television presenter for the television broadcast (see col. 52-67). Bahar teaches the system to include all forms of network communications known to one in the relevant technical art, such as the Internet, www, BBS, satellite system etc.

Regarding claims 11 and 73, Bahar does not teach the presenter is selected by the other participants. Official notice is taken that is old and well known in the art of chat or whiteboard for the presenter to be selected by any of the participants. It would have been obvious to one of ordinary skill in the art at the time of the invention to select a presenter in order to provide access to the chat or white board.

Regarding claims 16-20, 61, 62, 76-80, 89, 90, Bahar does not teach receive a selection of at least one competent authority from the other participants on the basis of suggested solutions delivered by the at least one competent authority via the network; and facilitate a private problem resolution discussion between a client and the selected at least one competent authority; wherein the client (Defense department) is the first participant or wherein the first participant is an employee of the client (Defense department). Rosenblatt teaches competent authorities selected and facilitating a private problem solution discussion (inherent feature of the Defense department (client) only discussing the issue with the selected participants). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow only competent authorities to participate or to be selected since there is a higher chance that the competent authorities would provide a better solution since they are experts in the field and to facilitate a private discussion to protect the project.

Claims 5, 12, 57, 68, 85 and 93-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar as (US 6,694,355) and further in view of Walker et al. (US 5862223).

Regarding claims 5, 12, 57, 68 and 85 Bahar failed to teach anonymously transmitting the formulation of the problem and receiving suggested solution, it is taught in Walker (see col. 10 lines 1-40). It would have been obvious to one of ordinary skill in the art to include such

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anonymity in Kaplan's online design solution since participants would like to stay anonymous in order to protect their privacy.

Regarding claims 93-103, Bahar does not teach quality assessment of the suggested solution, it is taught in Walker. Walker teaches the Exchange forwarding the request and the response to another qualified expert for review and the peer either accepts or rejects the response, and appropriate action is taken. Walker teaches if the response is rejected, the end user is refunded or offered an alternate expert. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to provide quality assessment of the suggested solution in Bahar's project design, if the client is not an expert, in order to make sure the client is receiving solution to the problem.

Claims 5, 12, 57, 68, 85 and 93-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar as (US 6,694,355) and further in view of Official Notice.

Regarding claims 13, 74, Bahar does not specifically teach the tools further adapted to block the further development of a selected suggested solution. Official notice is taken that well known in the art to set a deadline and to block the access after the deadline. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that Bahar's system would block access to the site after a deadline so that anyone who wants to participate knows that the deadline is over.

Response to Arguments

Applicant's arguments filed 9/14/06, with respect to the rejection(s) of claim(s) 1-22, 55-103 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bahar.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Linetsky et al. (US 6, 434,549) teaches human-mediated exchange of information and bidding for the service.


Smith, Jr. (US 5,662,478) teaches tool for creative thinking.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RETTA YEHDEGA
PRIMARY EXAMINER

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